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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,658	12/20/2001	James Michael Shumpert	384.7509USU	1146

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EXAMINER


NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 10/027,658	Applicant(s) SHUMPERT, JAMES MICHAEL	
	Examiner Tan Dean D. Nguyen	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 3-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-21 are directed to “A method for authenticating a business partner”, which is not within one of the classes of invention set forth in § 101.

The “A method for authenticating a business partner” comprising the steps of:

- (a) providing an identity of said business partner;
- (b) matching said identity of the business partner to a business that is one of a plurality of businesses for which a data record is stored in a business database; and
- (c) processing one or more data attributes of the data record with at least one business according to a set of authentication rules to determine if said business partner is authentic”, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The “method for authenticating a business partner” comprising the steps of (a)-
(c) as shown are:

(1) merely an abstract idea and

(2) does not reduce to a practical application in the technological arts (integration with computer/ computer network to produce an output result) and are therefore are found to be non-statutory.

See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 112

3. Claims 1-9, 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, (1) the preamble calls for "authenticating a partner" but the last step (c) calls for "to determine if the partner is authentic" which is vague and indefinite since the partner may not be authenticated. Step (c) does not achieve or complete the scope of the claim. Alternatively, the preamble could be changed to "A method for determining authentication of a business partner" to be proper with respect to the last step. Also, (2) in claim 1, there is no citation of "request or user" in the body of the claim which makes it vague and indefinite since they should be in the body of the claim to make it complete. Also, (3) step (b) is not clear because the phrase "matching said identity ... to a business" is vague since how can one matching an identity (which is an information or data) to a business? What does the business cover? (4) it's not clear the relationship

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between (b) and (c)? What is the relationship between “matching” and “processing attributes” or “authentication rules”?

Similarly, apparatus claim 10, which is similar to method claim 1 above with “means for” for carrying out steps (a) –(c) as shown in claim 1, has the same (4) issues as indicated in claim 1 above.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-5, 7, 10-14, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by GUSTAFSON (USP 5,659,731).**

As for independent method claim 1, GUSTAFSON, cited in the Background of the Invention pages 1-2, discloses a method for authenticating a business partner (entity, client) in response to a request of a user comprising:

(a) providing an identity of the business partner {see Fig. 1 (10), Fig. 6 (50), col. 4, lines 36-45 (or c4:36-45 for simplification)},

(b) matching said identity of the business partner with those identification attributes stored in a data record of a database {see Fig. 1 (14), c6:9-35}, and

(c) processing one or more data attributes of the data record with at least one business according to a set of authentication rules to determine the quality of the matching from none to perfect match {see Fig. 2, c6:25-53}. As for the limitation of “to

determine if the business partner is authentic, this is inherently included in the determination of the quality of the match with 100% represents perfect match or authentic business partner.

Note that applicant's comment on page 2 of the specification is the current system is slow compared to the speed required to satisfy the needs of user who transacts business on the web, but there are no limitations in claim 1 dealing with speed or the web.

As for dep. claim 2 (part of 1) which deals with further limitation of notifying the user and carrying out these steps automatically using a computer, the notifying step is inherently taught in Fig. 5 (66) or c11:35-40 wherein the "follow up" normally reads over contacting or notifying the user. As for the limitation of using a computer, this is taught in claim 10.

As for dep. claims 3-5 (part of 1), which deals with the forms of entry of data, i.e. standard template (or table or vertical form entries) for entry on computer, these are inherently included in the entry of GUSTAFSON which also use computer and online connection with the database {see Fig. 1 (10) , Fig. 2 (20)Fig. 3 "Entry", c12:44-60}.

As for dep. claim 7 (part of 1), which deals with an option, i.e. if step (b) fails to find a match, this carries no patentable weight since the examiner takes the position that step (b) is not failing.

Similarly, as for independent Apparatus claim 10, which has similar scope and elements as in claim 1 since it's the apparatus to carry out the method of claim 1, with limitations of "means for" for carrying out steps (a) –(c) as shown in claim 1, it's

rejected for the same reasons set forth in claim 1 above with the means to carry out the steps cited in GUSTAFSON.

As for dep. claims 11-14, 16 (part of 10), which have similar limitations as in dep. claims 2-5, 7 (part of 1) respectively, they are rejected for the same reasons set forth in claims 2-5, 7 above.

Claim Rejections - 35 USC § 103

6. Claims 6, 8-9, 15, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUSTAFSON as applied to claims 1-5, 7, 10-14, 16 above, and further in view of CAMACHO et al (US 2003/020 8648).

As for dep. claim 6 (part of 1), which deals authentication rules parameters, i.e. one or more current transactions with trade references, this is not taught in GUSTAFSON. However, CAMACHO et al discloses a method for authenticating an entity using authentication rules require one more current transactions with trade references {see Fig. 2 (212, 214, 216, 204), 0030, 0035, 0047, 0047, 0049} in order to (or for the benefits of) further protecting the user and provider from fraud or misuse by unauthorized individuals {see [0027]}. It would have been obvious to modify the authentication method of GUSTAFSON by using authentication rules require one more current transactions with trade references as taught by CAMACHO et al for the benefits of protecting the user and provider from fraud or misuse by unauthorized individuals.

As for dep. claims 8-9 (part of 1), which deal with authentication rules parameters, i.e. credential of the entity and wherein the credential is selected from one of the group consisting of purchase or financial account, etc., these are taught in

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CAMACHO et al on {[0012 "credential"], [0032], [0047], or Fig. 7A (410c), (410d), (414a)}.

As for dep. claims 15, 17-18 (part of 10), which have similar limitations as in dep. claims 6, 8-9 (part of 1) respectively, they are rejected for the same reasons set forth in claims 6, 8-9 above.

No claims are allowed.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 or (571) 272-6806 (by April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
March 15, 2005


DEANT. NGUYEN
PRIMARY EXAMINER